



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

*ml*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/058,840	04/13/98	WALKER	J 3178-4021US1

MORGAN & FINNEGAN  
345 PARK AVENUE  
NEW YORK NY 10154

LM02/0201

EXAMINER

LAUFER, P

ART UNIT	PAPER NUMBER
----------	--------------

2766

DATE MAILED: 02/01/00

*18*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/058,840

Applicant(s)  
Walker et al.

Examiner 703 306 4160  
Pinchus M. Laufer

Group Art Unit  
2766



☒ Responsive to communication(s) filed on 12 Jan 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 97 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 97 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 17

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

### **Part III DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Continued Prosecution Application***

2. The request filed on 12 January 2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/058,840 is acceptable and a CPA has been established. An action on the CPA follows.

#### ***Claim Rejections - 35 U.S.C. § 101***

3. Claim 97 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 97 is directed to matter which is not within the technological arts. *See Examination Guidelines for Computer Related Inventions 1184 OG 87 (3/26/1996) II.A* which states: The utility of an invention must be within the "technological" arts'. (*See Guidelines, 1184 OG at 95, Endnote 7.*)

#### ***Double Patenting***

4. Claim 97 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 23 of U.S. Patent No. 5,794,207 issued 11 August 1998. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the limitations of claims 97 of the instant application are taught in the claims of the issued patent. The patent is claimed more narrowly than the application as the steps are performed with the aid of a computer.

#### ***Information Disclosure Statements***

5. The IDS filed 12 January 2000 (Paper No. 17) consists of 21 sheets labeled "Sheet 1 of 1", "Sheet 1-9 of 9", and "Sheet 1-11 of 11". There are redundancies in the listings, including references listed twice and references already of record in the case.

6. The IDS dated 2 July 1999 (paper # 13) disclosing 21 related application is acknowledged. As these do not constitute prior art, and the items were not listed on a form 1449 no initialed copy is included with the office action. The files which were available were considered.

#### ***Claim Rejections - 35 U.S.C. § 102***

7. Claim 97 is rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Sibley, Jr. ('552). The bids are offers, the traders have associated financial accounts to back up their trades and there is a settlement procedure for transferring payment.

8. Claim 97 is rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Huberman ('244). Note that the bid is a conditional purchase offer in that it contains conditions which buyer requires to be met. Credit card accounts are discussed as one payment method at column 6 line 41.

***Conclusion***

9. This is a CPA of applicant's earlier Application No. 09/058,840. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Information Regarding Communication with the PTO***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pinchus M. Laufer whose telephone number is (703) 306-4160. The examiner can normally be reached on weekdays from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, G. O. Hayes, can be reached on (703) 305-9711. The fax phone number for this Group is (703) 308-9051.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

January 28, 2000

*Pinchus M. Laufer*  
**Pinchus M. Laufer**  
**Primary Examiner**  
**Art Unit 2766**